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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/633,943
Filing Date: August 04, 2003
Appellant(s): GORMAN, GREGORY WINFIELD

MAILED
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GROUP 1700

Heather F. Perrin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 2, 2007 appealing from the Office action mailed 12/4/2006 (Non-Final) and 5/7/2006 (previous Final).

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

However, regarding the amendment filed 7/17/2006 (after final amendment), appellant is correct to note that said amendment was denied entry and the amendment was not re-entered. The status of said amendment has not changed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

6514655	BASTIAENS	2-2003
6576074	CABRERA	6-2003
2003/0123930	JACOBS	7-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8,11,28-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The phrase "homogeneous composition" in claim 1 and 28 is not supported by the specification, as originally filed, because figures 5-13 merely describes the homogeneous structure and contains no description as to the identity or nature of the composition

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bastiaens (6514655).

Bastiaens relates to a pavement tape (col. 5, lines 27-28) comprising a continuous (col. 2, line 42) elongated flexible tape body (18) comprising front and rear surface, said front surface comprising at least one symbol (24) that conveys information. As shown in figures 1 and 2, the front and rear surfaces of the tape are exposed at an end.

As shown in figure-2, the rear face comprises an adhesive (36) covered with a release liner (37). The front face is provided with the information print and is covered by a transfer tape (7) that is understood to be releasably bonded to said front face. The symbols include commercial information (col. 5, line 35). The layer (30) is part of the symbol-containing tape and is reflective.

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The intended use phrases such as "for conveying information", "configured to be affixed", etc. have not been given any patentable weight because said phrase are directed to an intended use of the claimed product tape.

Regarding claims 11 and 19, the railing is not found to be of positive limitation as it is attached to the intend use pavement and not part of the claimed tape. Hence, it has not been given any patentable weight.

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Cabrera (US006576074B1).

Cabrera relates to a pavement tape (abstract and figure-1) comprising a continuous elongated flexible tape body comprising front and rear faces, said front face comprises at least one symbol conveys information (10), the at least one symbol formed as a perforation (14) extending at least partly from said front face to said rear face of said tape body (figure-2), wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body (figures-2 or 3).

The intended use phrase such as "for conveying information when affixed to pavement", etc. have not been given any patentable weight because said phrases are not found to be of positive limitation.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Jacobs (US 20030123930A1).

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Jacobs relate to pavement tape (figure-1) comprising an elongated flexible tape body (30) comprising front and rear faces (figure-1 shows the two faces of the tape body), said front face comprising at least one symbol that conveys information (figure-1 shows the depression on the front face that is interpreted to convey information such as indicating the location for the adhesive pattern), a mask tape (20), said mask tape comprising a flexible mask tape body having front and rear mask faces (as shown in figure-1) and at least one symbol formed as a perforation (32) extending from said front mask face to said rear mask face, said rear mask face of said mask tape being bonded to said front face of the pavement tape (figure-1 wherein the mask tape 20 is bonded to the pavement tape 30).

The intended use phrase such as "for conveying information when affixed to pavement", etc. have not been given any patentable weight because said phrases are not found to be of positive limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiaens.

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Bastiaens, as discussed above, fails to teach that the tape is 6-12 inches wide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape to have width of 6-12 inches for having the space to present visible printed information thereon, since it has been held that where the general condition of a claim is disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, the prior art tape is also a pavement tape having the structure as claimed.

Appellant should note that claim 15 (cancelled) has been deleted from this rejection as it was inadvertently listed with the rejected claims 6 and 33.

(10) Response to Argument

First, appellant's observation is appreciated in that the cancelled claim 15 was inadvertently listed with the claims 6 and 33 for the rejection under 35 USC 103(a). Said claim 15 has been removed from the rejection hereinabove. Examiner apologizes for the inconvenience caused thereby.

For the 35 USC 112, first paragraph, rejection appellant argues that, in claim 1, the claimed phrase "homogeneous composition" is supported by the application, such as the pictorial information in figures 5-13 which shows a homogeneous tape body. Appellant also argues that, per the dictionary definition (see page-9 of Appeal Brief), a homogeneous material is uniform in structure or composition throughout. These are not found to be persuasive because, while the shape of the claimed tape body shown in

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said figure are directed to a uniform structure, appellant is informed that a "homogeneous composition" is not the same as a "homogeneous structure". Further, for the dependent claims 2-8 and 11, said claims were rejected as being dependent from independent claim 1 and in response to appellant's argument for said dependent claims, the above explanation for claim 1 apply *a fortiori* herein. As for claim 28 and it's dependent claims 29-34, the above explanations provided for the 35 USC 112, first paragraph rejection of claim 1 apply *a fortiori* herein in that a "homogeneous composition" is not the same as a "homogeneous structure".

Responding to appellant's arguments for the rejections of claims 1 and 28 over the Bastiaens' reference, it is noted that Figure-2 of Bastiaens shows that the tape body (30) is of homogeneous composition because the body (30) is a polymeric material (Bastiaens, col. 4, lines 10-12). Bastiaens, in col. 4, lines 6-7, mentions that the body (30) has microspheres dispersed uniformly throughout the body indicating that the body has uniform composition. In the alternative, the presence of additional elements in homogeneous composition of the body (30) in Bastiaens is not precluded by the open language in said instant claims 1 or 28. Also, note that the body (30) shows a uniform and consistent composition, in that the presence of the microspheres (32) is uniformly dispersed in the body (30).

With respect to dependent claims 2-3, 5, 8 appellant 's argument for the "homogeneous composition" has been explained hereinabove.

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For claim 4, it is noted that "releasably bonded" phrase includes the presence of layer (7) in Bastiaens, figure-2, which is releasably bonded at the time it bonds the body (30) to transfer the elements (24). As for the argument that "there is no mention of adhesive property accorded to Bastiaens transfer sheet", please find that claim 4 also fails to recite the alleged adhesive property. All claim 4 recites is "releasably bonded" and said phrase is not limited to adhesive only (see Brief, page-19, lines 7-9 and page-20, lines 17-20).

In response to applicant's argument for claim 7, it is clear from Bastiaens that it is a retroreflective graphic article (see title) and, as such, the graphics (28) will exhibit "at least partially" reflective property.

For claim 11, the phrase "attachable to the pavement" is directed to an intended use of the railing with the pavement and not found to be part of the tape structure, as claimed. As for claim 28, the "homogeneous composition" phrase, the hereinabove explanation provided apply *a fortiori* herein.

Also, the features of dependent claims 29-34 have been addressed hereinabove.

With respect to claims 6 and 33, the arguments directed to "homogeneous composition" has been addressed hereinbefore.

As for appellant's arguments (for claim 9) regarding Cabrera, it is shown in figure-2 in Cabrera, that the perforation (e.g., 14) is taken to be a symbol "that conveys information" (see claim 9) because the perforation conveys the information of as to where to place the legends (10) on the body. Appellant's argument that Cabrera teaches a preferably

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black background layer, it is firstly noted that the instant claim 9 does not exclude black background layer, secondly, the black background layer of Cabrera is a "preferable" embodiment, and thirdly, appellant's claim tape is used with a pavement which is known to be black too. Appellant should also note that the presence of perforation to indicate the place where to place the legends would still perform as to convey information, irrespective of the background color. Appellant has failed to show as to how is the perforation of Cabrera different from that as is instantly claimed.

Appellant is informed that Cabrera teaches the structure as claimed in claim 9 which also does not recite the presence of adhesive as alleged in the Brief, page-30, second paragraph.

Appellant's position that the instant claimed tape is not the same as the tape (see Brief, page-30, last paragraph), in Cabrera, but acknowledges that the body of Cabrera is a HOTape, which is a tape.

For the Jacobs reference (rejection of claim 10), appellant is again directed to figure-1 wherein the depression is the portion of the tape body (30) containing the adhesive (26) therein. It is unclear as to why appellant is referring to (22) as the tape body, when in the rejection over Jacobs, it has been clearly mentioned that the tape body is (30). As for the depression conveying information, said depression conveys the information as to where the adhesive is located because the adhesive is provided in a pattern.

Also, contrary to appellant's argument, Jacobs' perforation (22) is located on the front face of mask layer (22). As for the argument that Jacobs array is "not applied on top of

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any pavement tape", it should be noted that "not applied" is directed to an intended use of the claimed product is not found to be of positive limitation, or a step of applying the mask on top of the tape. However, figure-1 in Jacobs clearly shows that the mask (22) is applied over the pavement tape body (30).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Nasser Ahmad

Conferees:


1. Romulo Delmendo

Appeal Conferee, TC 1700


2. Rena Dye

SPE, Art Unit 1772